

### EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to Applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.
2. Authorization for this examiner's amendment was given in a telephone interview with James E. Armstrong, IV on November 21, 2008.
3. The application has been amended as follows:
  - a. Please amend Claim 2, so that Line 2 of the claim recites:  
  
**transfer layer comprises the curable resin layer provided on the substrate film and a decorative**
  - b. Please amend Claim 3, so that Line 2 of the claim recites:  
  
**which is produced by laying a film (I) comprising the curable resin layer which is**

- c. Please amend Claim 4, so that Lines 2-4 of the claim recite:

**wherein the film (I) comprising the curable resin layer is provided on the substrate film, which is made of polyvinyl alcohol, and the temperature on heat lamination with the film (II), comprising the decorative layer provided on the peelable film, is from 40 to 120°C.**

- d. Please cancel Claim 9.

*Election/Restrictions*

4. Applicant's election without traverse of Group I, Claims 1-5 and 7-10, in the reply filed on August 7, 2008 is acknowledged. However, given that Applicant has cancelled Claim 11, which was previously non-elected, it is noted that the restriction requirement is no longer applicable and is therefore withdrawn.

*Response to Amendments*

5. Applicant's amendments to the abstract, filed August 7, 2008, with respect to conforming the abstract to the requirements regarding the language and format for the abstract of the disclosure, have been fully considered and are corrective. Therefore, the objection to the specification has been withdrawn.

6. Applicant's amendment to Claim 4, filed August 7, 2008, with respect to changing the reference number in the second line of the claim from an alphanumeric character to a roman numeral, has been fully considered and is corrective. As such, the objection to Claim 4 has been withdrawn.

7. Applicant's amendment to Claim 1, filed August 7, 2008, obviates the previously cited rejection under 35 U.S.C. § 112. Consequently, the rejection of Claim 1-5 and 7-10 under 35 U.S.C. § 112, second paragraph, as being indefinite, has been withdrawn.

*Allowable Subject Matter*

8. Claims 1-5, 7, 8 and 10 are allowed.

*Examiner's Statement of Reasons for Allowance*

9. The following is an examiner's statement of reasons for allowance: In the Office Action mailed on May 14, 2008, Claims 1-5 and 7-10 were rejected as being provisionally rejected on the grounds of nonstatutory obviousness-type double patenting, as being unpatentable over Claims 1 and 3-6 of the copending U.S. Patent Application Publication of Ariga et al. (2007/0042163; hereinafter "Ariga"). Based upon the amendments made to the claims in the amendment filed on August 7, 2008, Ariga is

now a close art reference to that which is claimed in the instant application. However, it is noted that Ariga is not applicable as prior art against the present claims in light of the effective filing date. It is also noted that Ariga was cited as a reference in the rejection based on nonstatutory obviousness-type double patenting. However, if a “provisional” nonstatutory obviousness-type double patenting rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. (*See* MPEP § 804(B)(1)).

10. Additionally, the U.S. Patent of Kawaharada et al. (6,902,642; hereinafter “Kawaharada”) is the closest prior art to that which is claimed in the instant application. However, Kawaharada fails to teach or suggest the incorporation of a peelable film that is provided on a transfer layer, which can be peeled off at the interface with that transfer layer.

11. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### *Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056.

The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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/DJJ/

Examiner, Art Unit 1794

11/18/2008

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794